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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,451	06/12/2002	Helmut Klein	BM-85PCT	2843

7590 05/11/2004
Friedrich Kueffner
317 Madison Avenue
Suite 910
New York, NY 10017

EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,451

Applicant(s)

KLEIN ET AL.

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

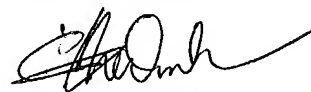
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02232004
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: Attachment

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1. The Amendment filed on February 23, 2004 has been entered.
2. The drawings were received on February 23, 2004. These drawings are accepted by the Examiner.
3. The original drawings, such as, Figs. 5, 6, and 8, are objected to because the drawing symbols are improper. For example, page 7 of the specification describes that the cover part 32 is made of a soft plastic or rubber-elastic plastic material, however, Figs. 6 and 8 do not show the drawing symbol for rubber or plastic in accordance with MPEP 608.02.
4. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

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A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

5. Claims 2, 3, 5-7, and 17 are objected to because of the following informalities:

(A) No antecedent basis is seen for the terms, such as, "the area" in claim 2 and "the switching elements" (plural, emphasis) in claims 3 and 5-7; and

(B) The claims contain typographical error, e.g., "cutout (27)" in claim 17 should have been "cutout (14)."

Appropriate correction is required.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 4, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

It is unclear whether:

(A) The terms that appear at least twice, such as, "a touch surface" in claims 1 and 4, and "a base shell" in claims 1 and 14 refer to the same or different things. See MPEP 2173.05(o); and

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(B) A confusing variety of terms, such as, "water-tight" in claim 1 and "media-tight" in claim 13 refer to the same or different things. See MPEP 2173.05(o) and MPEP § 608.01(o).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 5-7, 9-12, and 15-18, and claims 4, 13, and 14, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Boom et al. (DE 196 17 038 A1 published on November 6, 1997 and cited by applicants).

Regarding claim 1, Boom et al. (which corresponds to US Patent No. 6,075,294) teaches a closing system for motor vehicles, comprised of a handle 13 comprised of two shells 28 and 29, one of which is a base shell, and a lock 37 on the vehicle on at least one door 12 as well as an electronic control 16, wherein the lock 37 can be switched between two states, i.e., a first state, preventing opening of the door 12 and a second state, allowing opening of the door 12, and wherein in the area of the handle 12 at least one switching element 30, 33 is arranged with which the electronic control 16 can be activated, via which the lock 37 can be transferred from its first state into the second state allowing opening of the door 12, wherein the switching element 30, 33 is in a container 36 integrated water-tight, and the container 36 on at least one side has a touch surface (i.e., a top surface of the container 36, see Attachment) for actuating the switching element 30, 33 and the container 36 is introduced without play into a receptacle (Att.) of the base shell 28 of the handle 13, and the base shell 28 of the handle 13 has a window cutout (Att.) in its

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outer wall (Att.) in the area of the receptacle (Att.) in which, when the container 36 is inserted into the receptacle (Att.), the touch surface (Att.) is positioned in a form-locking manner (see the translation in USP 6,075,294, column 4, lines 33-66).

Claim 1 and other claims below are anticipated by Boom because when Boom's handle 13 is in disassembled state as show in Boom's Fig. 3, the user can touch the outer surface of Boom's container 36. Therefore, the outer surface of Boom's container 36 is "read on" the claimed "touch surface." It is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "*read on*" something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are "*fully met*" by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983). On the other hand, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, note that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 U.S.P.Q.2d 1429 (CAFC 1997).

Regarding claim 2, in the area of the receptacle, guides (Att.) are provided in the handle 13 for shock-safe securing of the container 36.

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Regarding claim 3, the switching elements 30, 33 are electronically operating push switching elements.

Regarding claim 4, an additional switching element 35 for securing the losing system is mounted in the handle 13 which can be actuated by a touch surface 35.

Regarding claim 5, the switching elements 30, 33 are microswitches.

Regarding claim 6, the switching elements 30, 33 are pressure sensors.

Regarding claim 7, the switching elements 30, 33 are switching foils.

Regarding claim 9, the additional switching element 35 for securing the closing system is integrated into the container 36.

Regarding claim 10, the additional switching element 35 for securing the closing system is arranged at the (outer) side of the container 36 opposite the touch surface (Att.).

Regarding claim 11, the container 36 is an enclosed component.

Regarding claim 12, the container 36 is of a unitary configuration and the switching element 30, 33 is enclosed in its container interior (Fig. 4).

Regarding claim 13, the container 36 is closed in a media-tight way (see the translation in USP 6,075,294, column 4, lines 43-45).

Regarding claim 14, the handle 13 is comprised of a base shell 28 comprising the receptacle (Att.) and a cover part 29.

Regarding claims 15 and 16, the window cutout (Att.) is arranged on the side of the handle 13 facing the door 12 (Fig. 1)

Regarding claim 17, the switching element 30, 33 for securing the closing arranged in the window cutout (Att.) arranged at the side of the handle 13 facing away from the door 12 (Fig. 1).

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Regarding claim 18, on the touch surface (Att.) of the container 36, markings (shown by dashed lines) that are characterized and/or can be felt by touch are provided.

10. Applicants' arguments filed February 23, 2004 have been fully considered but they are not persuasive.

DRAWINGS

The replacement sheets of Figs. 1, 3, 4, and 7 have been approved. However, the original Figs. 5, 6, and 8 are still objected to because, e.g., the drawing symbols are not complied with American National Standards Institute Inc. See MPEP 608.02.

35 USC 112, FIRST PARAGRAPH

The rejection under 35 USC 112, first paragraph, is withdrawn, in light of applicants' own admission that the lock allows the door to open and close in a conventional manner and applicants' invention is limited to the switching elements and its arrangement in the container and the handle. See pages 13 and 14 of Paper No. 02232004.

35 USC 112, SECOND PARAGRAPH

Applicants assert that the claims now on file particularly point out and distinctly claim the subject matter regarded as the invention. The examiner respectfully submits that claims 4, 13, and 14 are still indefinite due to, e.g., double inclusion problem.

11. Applicants' arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' amendments, such as, the showing of the door, lock, and electronic control in Fig. 1, the additions of the limitations, e.g., "one of which is a base shell," "water-tight," "form locking manner" in claim 1, and the cancellation of "or the like" in claim 1 and claim 8, etc. to

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overcome the previous rejections under 35 USC 112 necessitate new ground of rejection based on DE 196 17 038 A1 newly cited by applicant. Therefore, applicants' arguments that the application is now in the condition for allowance are deemed to be moot.

12. Applicants' submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on February 23, 2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

May 7, 2004



Vinh T. Luong
Primary Examiner

Application/Control Number: 10/088,451

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ATTACHMENT

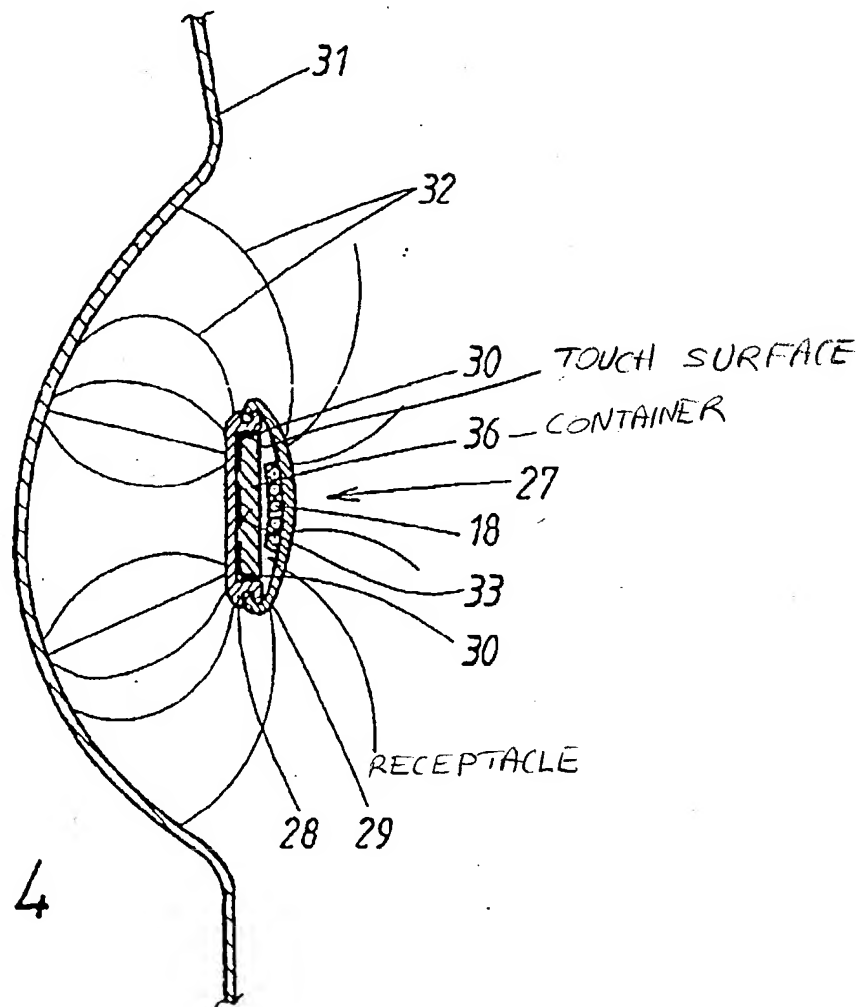


FIG. 4

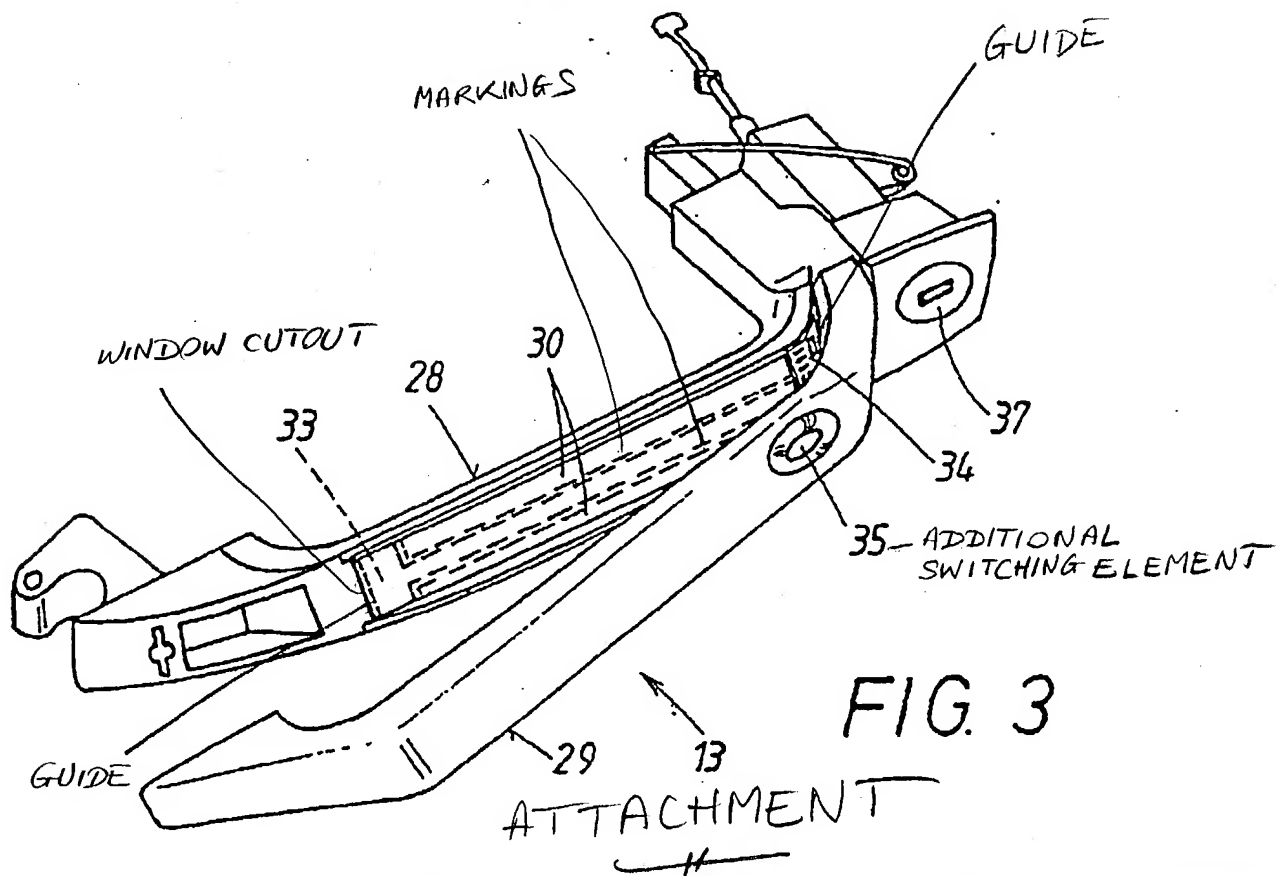


FIG. 3